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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,875	09/19/2000	Herbert D. Jellinek	55408-0502	5331

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EXAMINER

WON, YOUNG N

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 11/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,875

Applicant(s)

JELLINEK, HERBERT D.

Examiner

Young N Won

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-18 have been examined and are pending with this action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 5 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Cragun et al. (US 5804803 A).

As per claims 5 and 12, Cragun teaches a method and a computer-readable medium carrying instructions (see col.6, lines 21-25) for performing a server action that

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requires user input (see abstract), the method and instructions comprising the steps of: storing, at a location accessible to a server machine (see Fig.1B, #126 & #132; and col.2, line 66 to col.3, line 28), one or more mappings between abbreviated substrings and expanded substrings (see Fig.2; Fig.4; col.2, lines 31-35; col.6, lines 21-25; and col.8, lines 35-38); receiving from a client machine (see col.12, lines 22-29) an unexpanded input string that includes an abbreviated substring (see col.5, line 65 to col.6, line 3; and col.7, lines 15-19 & 38-41); determining whether said abbreviated substring is constrained to be identically produced (see Fig.6A, #616; and col.6, lines 6-9); if said abbreviated substring is constrained to be identically produced, then performing said server action using said abbreviated substring without expanding said abbreviated substring (see Fig.6A, Step 616 = False, proceeds to Fig.6B, Steps 620 and 622); and if said abbreviated substring is not constrained to be identically produced, then performing the steps of inspecting a mapping, of said one or more mappings, to determine an expanded substring that corresponds to said unexpanded substring (see Fig.2; Fig.4; Fig.7; col.2, lines 31-35; col.6, lines 21-25; and col.8, lines 35-38); and performing said server action using said expanded substring (see Fig.6B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cragun et al. (US 5804803 A) in view of Nunberg et al (US 5111398 A).

INDEPENDENT:

As per claims 1 and 4, Cragun teaches a method of operating a server machine to expand or a server machine (see Fig.1B) for expanding input strings of characters received from client machines (see Fig.1A) that include character input devices (see Fig.1A, #116 & #118), comprising: a processor (see Fig.1B, #124) and connecting circuitry for connecting the processor to a user's client machine (see col.11, lines 19-21) that includes a character input device (see Fig.1A, #121 and Fig.1B); storing, in a location accessible to said server machine (see Fig.1B, #126 & #132; and col.2, line 66 to col.3, line 28), one or more mappings between abbreviated substrings and expanded substrings (see Fig.2; Fig.4; col.2, lines 31-35; col.6, lines 21-25; and col.8, lines 35-38); receiving, at the server machine (see col.12, lines 22-29), an unexpanded input string of characters from a client machine that includes a character input device, the unexpanded input string including at least one abbreviated substring (see col.5, line 65 to col.6, line 3; and col.7, lines 15-19 & 38-41); each abbreviated substring belonging to a set of abbreviated substrings in an applicable mapping of said one or more mappings (see Fig.4 and col.6, lines 17-20); and automatically finding one of the abbreviated substrings (see Fig.2; Fig.4; col.2, lines 31-35; col.6, lines 21-25; and col.8, lines 35-38);

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determining, based on said applicable mapping, that the abbreviated substring corresponds to a particular expanded substring, and producing an expanded input string that is a version of the unexpanded input string with the abbreviated substring replaced by said particular expanded substring (see Fig.2; Fig.4; Fig.7; col.2, lines 31-35; col.6, lines 17-25; and col.8, lines 35-38). Cragun does not explicitly teach that in his system, the expansion is performed at the server, but he does teach that such means can be incorporated in an alternative embodiment (see col.11, lines 64-68). Cragun does not explicitly teach that the unexpanded string includes word delimiters preceding and following the abbreviated substrings or that the finding the abbreviated substrings is based on the preceding and following word delimiters. Nunberg teaches of delimiters preceding and following substrings (see Fig. 6 and col.13, lines 50-53) and finding substrings based on delimiters (see Fig.5 and col.13, lines 31-32). It would have been obvious to a person of ordinary skill in the art to employ the teachings of Nunberg within the system of Cragun by implementing delimiters proceeding and following substrings to identify the substrings because delimiters are well known in the art for identifying the boundary of data and such an implementation allows clients to make multiple requests at one time by employing delimiters to partition the requests.

DEPENDENT:

As per claim 2, Cragun further teaches wherein one of the abbreviated substrings begins with a character and represents an expanded substring that begins with the same character and in which the step of determining that the abbreviated substring

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corresponds to a particular expanded substring comprises: determining the case of the beginning character in the abbreviated substring; and giving the determined case to the beginning character in the expanded substring (see Fig.2: "H").

As per claim 3, Cragun further teaches wherein one of the abbreviated substrings represents expanded substrings that depend on time and in which the step of determining that the abbreviated substring corresponds to a particular expanded substring comprises: performing a computation to obtain an expanded substring based on the current time; and producing the expanded input string with the abbreviated substring replaced by the expanded substring based on the current time (see col.10, lines 34-40).

As per claims 6 and 13, Cragun further teaches wherein: the client machine is operated by a particular user; and the method further includes the step of determining which mapping of said one or more mappings to inspect based on identity of said particular user (see Fig.4).

As per claims 7 and 14, Cragun further teaches wherein the step of determining which mapping to inspect includes the steps of: identifying which group of a plurality of groups includes said particular user, and identifying a mapping associated with the group that includes said particular user (see Fig.4 and col.11, line 38: "fan clubs").

As per claims 8 and 15, Cragun does not explicitly teaches of further comprising the step of determining which mapping of said one or more mappings to inspect based on which type of server action is requested by said client machine. However these differences are only found in nonfunctional descriptive material and are not functionally

involved in the steps recited. The mapping and expanding would be performed regardless of the data so long as the mapping data is stored. Thus this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir.1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to collect from the customer any type of data having any type of content because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 9 and 16, Cragun further teaches wherein: the method further comprises the step of determining a current time; and determining which substring of a plurality of substrings corresponds to said unexpanded substring based on the current time (see claim 8 rejection above).

As per claims 10 and 17, Cragun further teaches wherein the step of determining which substring corresponds to said unexpanded substring includes: expanding said unexpanded substring to a first expanded substring without regard to current time; and expanding said first expanded substring to a second expanded substring based on the current time (see claim 8 rejection above).

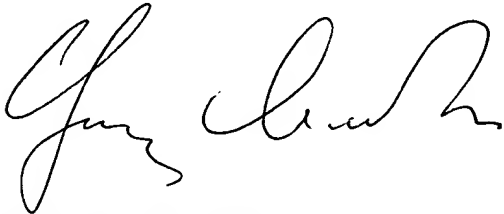
As per claims 11 and 18, Cragun further teaches wherein the step of performing said server action using said expanded substring is performed without sending said expanded substring to said client machine (see col.11, lines 64-67).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Young N Won whose telephone number is 703-605-4241. The examiner can normally be reached on M-Th: 8AM-6PM.

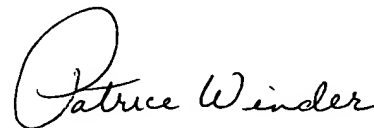
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T Alam can be reached on 703-308-6662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Young N Won



November 13, 2003



**PATRICE WINDER
PRIMARY EXAMINER**